UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/593,060	06/13/2000	Tatsuya Eguchi	52178-020	5731

20277   7590   12/27/2005

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EXAMINER
HAN, QI

ART UNIT	PAPER NUMBER
2654	

DATE MAILED: 12/27/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

> A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
> - Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
> - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
> - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
> Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on <u>09 November 2005</u>.

2a) ☒ This action is **FINAL**.   2b) ☐ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) *1-18* is/are pending in the application.

     4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) *1-18* is/are rejected.

7) ☒ Claim(s) *1* is/are objected to.

8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.

     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

     a) ☐ All b) ☐ Some * c) ☐ None of:

       1. ☐ Certified copies of the priority documents have been received.

       2. ☐ Certified copies of the priority documents have been received in Application No. _____.

       3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

     * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
     Paper No(s)/Mail Date _____.

4) ☐ Interview Summary (PTO-413)
     Paper No(s)/Mail Date. _____.

5) ☐ Notice of Informal Patent Application (PTO-152)

6) ☐ Other: _____.

DETAILED ACTION

1.   The text of those sections of Title 35, U.S. Code not included in this action can be found

in a prior Office action.

Response to Amendment

2.   This communication is responsive to the applicant's amendment filed on 09/26/2005.

Applicant amended claim 1.

The examiner withdraws the claim rejection under 35 USC 112, since applicant amended

the claim(s) and/or clarified part of the claimed limitations.

Response to Arguments

3.   Applicant's arguments filed on 09/26/2005 with respect to claims 1-18 under 35 USC 103

have been fully considered but they are not persuasive. It is noted that even though the applicant

amended claim 1, the claims and the argument still cannot overcome a rejection based on the

previous cited references (see detail claim rejection below).

        In response to applicant's arguments with respect to claim 1 (also applied to claim 14) .

that that "the rejection are respectfully traversed" particularly for limitations "**controls said**

output unit so as to output the translated document data by groups" and ""**controls said**

output unit so as to output the translated document data translated into the first and

second language as a common group" (amendment: page 12), Primary reference (Yamauchi)

"never discloses or suggests" the claimed limitation (amendment: page 13, paragraphs 1-2), and

if combining Yamauchi with Flores (secondary reference), it will result in different outcome

from the claimed limitation (amendment: page 13, paragraph 3 page 14, paragraph 3), the

examiner respectfully disagrees with applicant's arguments and has a different view of the prior

art teachings and the claim interpretations.

It should be pointed out that the scope of the claimed limitations is broader than that of

argument, because the claimed limitation "output..." is not limited by printing on paper.

Further, it is noted that Yamauchi teaches both a general feature of outputting document in the

first and/or second languages (col. 4, lines 37-52) and specific feature of outputting document in

the first and second languages on two side of a sheet (col. 4, lines 53-60), including outputting

text data to a personal computer through telecommunication (col. 7, lines 52-59), which clearly

suggests that Yamauchi does not limited his invention only for the specific feature argued by the

applicant (amendment: pages 13-14).

Furthermore, as stated in the claim rejection, Flores teaches translation of documents in

multiple languages and a variety of formats and using computer displaying in two or more

separate languages (col. 3 lines 67 to col. 4, line 10 and Figs. 2-6). It would have been obvious

to one of ordinary skill in the art at the time the invention was made to modify Yamauchi by

providing translation of documents in multiple languages and a variety of formats and using

computer displaying in two or more separate languages, as taught by Flores, for the purpose of

being beneficial to users presenting and displaying a written text and its multiple translations in

two or more separate languages (Flores: col. 4, lines 5-8). Therefore, the combined system by

the two references has capability of implementing the feature of the claimed and argued

limitations in claims 1 and 14, wherein the output of a document by respective paragraphs and

their orders (Yamauchi: Fig. 24, col. 5, lines 56-67) and viewing and choosing two or more

languages presented adjacently on display (Flores: col. 6, lines 47-54 and Figs. 3-5B) can be, at

least in sense of broadest reasonable interpretation, read on the claimed/argued "output ...by

groups" (claim 1) and "output ...by a common group" (claim 14).

4.   The response to applicant's arguments with respect to claims 6, 11 and 17 is based on the

same or similar reason as described for claims 1 and 14 (see above). Further, it is noted that the

claimed limitations (in claims 6, 11 and 17) are not the same as the argued recitation "a

document including..." (see amendment: page 14, paragraph 4). In response to applicant's

argument that the references fail to show certain features of applicant's invention, it is noted that

the features upon which applicant relies (i.e., "a document including...") are not recited in the

rejected claim(s). Although the claims are interpreted in light of the specification, limitations

from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26

USPQ2d 1057 (Fed. Cir. 1993). Furthermore, it should be pointed out that the limitation

"document data" is broad and can be interpreted in may ways, including a single or multiple

documents, files, pages, paragraphs, sentences, phrases, words (tokens), content tables, database

text records, any combination thereof, etc., so that the combined reference teachings in the

rejection are properly read on the claimed limitations, based on broadest reasonable

interpretation of the claims.

In addition, in response to applicant's argument regarding establishing a prima facie

basis, the examiner recognizes that obviousness can only be established by combining or

modifying the teachings of the prior art to produce the claimed invention where there is some

teaching, suggestion, or motivation to do so found either in the references themselves or in the

knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071,

5 USPQ2d 1596 (Fed. Cir. 1988)and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir.

1992). In this case, a prima facie case is based on the prior art teachings, because both

references (Yamauchi and Flores) teach to solve the same or similar problems that includes

translating document and outputting one or more documents in different languages, by using a

computer system. As stated in the claim rejection, Yamauchi's invention can translate a first

language into a second language and output the first language and the second language, and

Flores's system can translate and output multiple languages. Therefore, it would have been

obvious to one of ordinary skill in the art at the time the invention was made to modify

Yamauchi by providing translating and outputting multiple languages, as taught by Flores, for

the purpose (motivation) of being beneficial to users presenting and displaying a written text and

its multiple translations in two or more separate languages (Flores: col. 4, lines 5-8). Thus, the

prima facie basis is properly established.

Claim Objections

5.   Claim 1 is objected to because of the following:

Regarding claim 1, the amended claim limitation "the language of each language group

consisting of one of the plurality of languages" (amendment: page 2) is different from the argued

limitation "the language of each language group **being** one of the plurality of languages". It is

reminded that the limitations in different words might have different interpretations. Appropriate

correction or confirmation is required.

Claim Rejections - 35 USC § 103

6.   Claims 1-2, 4-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Yamauchi et al. (5,701,497) hereinafter referenced as Yamauchi, in view of Flores et al.

(6,370,498 B1) hereinafter referenced as Flores.

As per **claim 1**, Yamauchi teaches a translating apparatus comprising:

"translating means for translating document data into another language" (Fig.1 and col. 7,

lines 41-54, 'translation unit 9');

"an output means for outputting the translated document data translated by said

translating means" (col. 4, line 36 to col. 5, line 11, 'output means for outputting said received

document (including translated document data); Fig. 1, 'bitmap exp 10' and 'plotter 11', 'PC/WS

12'; col. 7, lines 54-55, 'the translating unit 9 supplies the output text data...for transfer to the

personal computer 12');

"a mode setting unit for setting the translating apparatus in a first mode or a second

mode" (col. 4, lines 36-60, 'wherein one of said first and second output means is selectively

activated (mode setting)');

"a controller", (col.,7, lines 55-56, 'the system of Fig. 1 includes a system controller',

which necessarily controls each unit, such as 'OCR', 'translation' and 'outputs text data

representing the result of translation');

"wherein, in a case where the first (or second) mode is set, said controller controls said

translating means so as to translate the document data into" a target language "different from

[one another] an original language of the document data" and "controls said output unit so as to

output the translated data", (col. 4, lines 39-45, 'translating a received document, written in a

first language, to a second, different language...output...in said second language... wherein one

of said first and second output means is selectively activated (setting mode)'; col.,7, line 48,

'outputs text data representing the result of translation');

    "wherein, in a case where the second mode is set, said controller controls said translating

means so as to translate the document data into" a target language "different from [one another]

an original language of the document data" and "controls said output unit so as to output the

translated data translated by groups, each group of the translated document data comprising the

original language and the translated document data", (col. 4, lines 39-45, 'translating a received

document, written in a first language, to a second, different language...output means for

outputting...simultaneously (another mode) in said first language and said second language';

Fig. 24, shows the output of the document in the original and target languages by respective

paragraphs and their orders (interpreted as by group)).

    But, Yamauchi does not explicitly teach translating "the document data into a **plurality**

of languages different from one another" and outputting the data by certain group(s). However,

this feature is well known in the art as evidenced by Flores who discloses apparatus and methods

for multilingual user access (title), comprising that 'the database stores translation of documents

in multiple languages and a variety of formats', 'user can choose to have the multiple

translations' and 'to have a work displayed (output) in a written text in two or more separate

languages' (Figs. 3-4 and col. 3, line 64 to col. 4, line 8, and col. 5, lines 27-57), viewing and

choosing two or more languages presented adjacently on display (col. 6, lines 47-54 and Figs.

5A-5B), which suggests the system has capability of outputting multiple languages in different

combinations, including groups, such as different formats (contents) in one of languages (by

language groups), or one of formats in different languages (by groups or common groups).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention

was made to modify Yamauchi by providing translating document data in multiple languages

and outputting (displaying or printing) the data in different languages, as taught by Flores, for the

purpose of being beneficial to users presenting and displaying a written text and its multiple

translations in two or more separate languages (Flores: col. 4, lines 5-8).

As per **claim 2**, Yamauchi further teaches "said output unit includes a printing device for

printing the translated document in a sheet" (Fig. 1, 'plotter 11').

As per **claim 4**, Yamauchi in view of Flores teaches that "said output unit includes a

display for displaying the translated document data" (Yamauchi: Figs. 2 and col. 8, lines 33-34,

'display unit 33').

As per **claim 5**, Yamauchi in view of Flores teaches "an operation unit for specifying an

original language and a plurality languages to be translated" (Yamauchi: Figs. 2 col. 7, lines 62,

'system controller', 'input device 32.. used by an operator'; Flore: Figs 2-4, which necessary

includes specifying the related languages for the translation).

Claims 6-18 are the same in scope and content as claims 1-2 and 4-5 above and therefore

are rejected under the same rationale.

7.   Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Yamauchi in view

of Flores, and further in view of Miyahara et al. (6,314,213 B1) hereinafter referenced as

Miyahara.

        As per **claim 3** (depending on claim 2), Yamauchi in view of Flores does not explicitly

teach "said output includes a sorter for sorting printed sheets by the group". However, this

feature is well known in the art as evidenced by Miyahara who teaches using 'a sorter 22' for

discharging 'paper sheet' (Fig.2) (col. 7, lines 28-29) and 'a soft key which is used to sort,

staple/sort') (col. 8, line 12). Therefore, it would have been obvious to one of ordinary skill in

the art at the time the invention was made to combine Yamauchi in view of Flores with Miyahara

by providing a sorter and related sorting functionality, as taught by Miyahara, for the purpose of

implementing user preferred function, like sorting the resultant sheets, (Miyahara: col. 8, lines 4-

13).

Conclusion

8.   Applicant's amendment necessitated the new ground(s) of rejection presented in this

Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a).

Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a). A

shortened statutory period for reply to this final action is set to expire THREE MONTHS from

the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the

mailing date of this final action and the advisory action is not mailed until after the end of the

THREE-MONTH shortened statutory period, then the shortened statutory period will expire on

the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be

calculated from the mailing date of the advisory action. In no event, however, will the statutory

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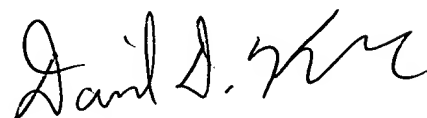the address.

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          QH/qh
          December 13, 2005

                                                        DAVID D. KNEPPER
                                                        PRIMARY EXAMINER